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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,707	08/02/2001	Ben Byrd	41872-206195	6769

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EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 04/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,707

Applicant(s)

BYRD, BEN

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Examiner Declaration*.

Claim Rejections - 35 USC § 112

1. Claims 7, 9-13, 15, 20, 22-26, and 31-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7 the phrases “further comprising a pair of shoes” and “on each of a left and a right shoe of a pair of shoes” contradicts the preamble of “The shoe...” rendering the claims vague and indefinite because it is not clear if applicant is claiming a single shoe or a pair of shoes.

Claims 9-11, 22-24, 32, and 33 and in claims 12, 25, and 34 the phrase “corresponding to the plurality of shoe size indicator lines comprise standard shoe sizes for toddlers, children, youth, or adults and gender-specific lengths and widths” are vague and indefinite and it is not clear what further structural limitations applicant intends to encompass with such language.

In claims 11 and 24 the phrase “patterns having appeal to toddlers, children, youth, or adults that would typically wear the shoe sizes” is vague and indefinite because it claims the shoe in reference to an appeal of a person which is undefined, unknown, and unbounded. It is not clear what structural limitations applicant intends to encompass with such language.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 7, 9-11, 14-18, 20, 22-24, 27-29, 32, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Berger (5084988).

Berger shows shoe soles and method of using shoe soles having a heel indicator (boundary between elements 4 and 5), and a plurality of calibrated lines (6 and boundary between elements 3 and 5) with indicia comprising calibrated numbers and/or lines (6 and 7, see column 3 lines 1-10) as claimed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 12, 19, 25, 30, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger in view of official notice/examiners declaration/attached photocopies of soles of shoes over 10 years old.

Berger shows shoe soles and method of using such substantially as claimed except for printing the actual size of the shoe on the bottom of the shoe sole. It is extremely well known and conventional to print the shoe size on the bottom of soles as shown by the attached pictures of the soles of shoes which were sold in the US in the early 1990's. It would have been obvious to print the shoe size on the outsole as is well

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known and conventional in the shoes of Berger to make it easier to locate properly sized shoes in a store.

6. Claims 8, 13, 21, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger in view of either Rosen (4931773) or Sigoloff (4712314).

Berger shows shoe soles and method of using such substantially as claimed except for providing a transparent layer over the bottom of the outsole. Rosen or Sigoloff teaches providing a transparent layer (34 or 26) on an outsole over an area of indicia. It would have been obvious to provide a transparent layer as taught by Rosen or Sigoloff in the shoes and method of Berger to increase the durability and to make the indicia easier to read after the shoes have been worn.

Response to Arguments

7. Applicant's arguments filed 2/18/03 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards Berger, Berger clearly shows and describes "calibrated markings are applied in the form of lines and/or numbers..." (column 1 lines 50-55), "calibrated markings ...in the form of lines 6 and/or numbers 7" (column 3 lines 1-3), and "Nontransparent edge 5, in the front sole area, can basically, also be used for calibration or marking of the correct shoe size" (column 3 lines 62-64). The definition of calibrate is "to fix, check, or correct the graduations of (a measuring instrument)" and the definition of graduation is "an arrangement or classification into grades according to amount, size, etc.". Therefore calibrated markings are clearly considered to be markings which are used as a measuring device to coordinate to an

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arrangement or classification of sizes according to the definitions. The recitations of Berger appear to merely be definitions of a "shoe size" indicator. Clearly if edge 5 is defined as marking the correct shoe size, the other markings inherently mark smaller shoe sizes.

In response to applicants' request for a reference showing that printing the shoe size on the bottom of shoe soles is well known and conventional, numerous shoes which the Examiner has owned for at least 10 years are representative of such and a Declaration to such is attached. Such practice is extremely well known and conventional and can be found on the bottom of shoes in every shoe store that the Examiner has ever been into.

In response to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. In re Keller, 208 USPQ 871 (CCPA 1981).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what

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they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, the use of transparent materials to allow indicia to be seen, but also protected is extremely obvious and a known property of transparent materials. Both Rosen and Sigoloff are examples of the use of transparent materials to allow indicia to be seen and protected.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's

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convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.

A handwritten signature in dark ink, appearing to read 'Marie Patterson', with a long horizontal flourish extending to the right.

Marie Patterson
Primary Examiner
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